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| APPLICATION NO.  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO.         | CONFIRMATION NO.       |
|--|-------------|----------------------|-----------------------------|------------------------|
| 10/768,972   | 01/30/2004  | Patrick Cruchet      | DNAG-275                    | 4547                   |
| 24972 7590 12/14/2007<br>FULBRIGHT & JAWORSKI, LLP<br>666 FIFTH AVE<br>NEW YORK, NY 10103-3198 |             |                      | EXAMINER<br>WILLSE, DAVID H |                        |
|  |             |                      | ART UNIT<br>3738            | PAPER NUMBER           |
|  |             |                      | MAIL DATE<br>12/14/2007     | DELIVERY MODE<br>PAPER |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/768,972

Applicant(s)

CRUCHET ET AL.

Examiner

Dave Willse

Art Unit

3738

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 20 September 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 4, 8, 12, 13, 17 and 20 is/are allowed.
- 6) ☒ Claim(s) 1-3, 5-7, 9-11, 14-16, 18, 19, and 21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

The disclosure is objected to because there is no reference character **21** in Figure 2 and no reference character **20** in Figure 5, contrary to what is stated in the first two sentences of the new paragraph submitted on July 16, 2007. In claim 1, line 6, "diameter" should be replaced by -- diameters--. Appropriate correction is required.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 14, line 6 lacks proper syntax.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 6, 11, 16, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Bouvet, EP 0 461 019 B1: Derwent abstracts; Figures 1 and 2. Regarding claim 1, Figure 1 depicts the diameter of the outer slide surface of the bipolar shell **8** and **15** to be about twice the diameter of the ball head **2** so that the ratio as claimed is approximately two, which

clearly falls within the specified range. Regarding claim 11, the bipolar shell can alternatively be interpreted as the cup 15 only, said cup being monolithic and of a single material; nothing in present claim 11 requires that the bipolar shell directly contact the socket.

Claims 2, 3, 5, 7, 9, 10, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bouvet, EP 0 461 019 B1. Regarding claim 2, the aforementioned ratio being 5 would have been an obvious variant in view of the curvature radius of the cavity 12 being “considerably smaller” than the curvature radius 43 of the cavity 5 (second Derwent abstract, lines 5-6 and 11-13) and in the absence of any disclosed criticality for this particular value (*In re Geisler*, 116 F.3d 1465, 43 USPQ2d 1362 (Fed. Cir. 1997)). Regarding claim 5 and others, the offset (Figure 1; column 8, lines 32-34) being somewhere between 0.1mm and 5mm would have been obvious from the range of hip joint sizes in human and animal anatomies and would have led to predictable results, particularly in the absence of any disclosed criticality for the claimed values. The dimensions set forth in claims 3, 7, 10, and others would have been obvious for similar reasons.

Claims 1, 11, and 21 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by McLean, US 2002/0116068 A1: Figures 12 and 13; paragraphs 0009; 0050; and 0051. Regarding claim 1, the outer diameter of the inner shell 78 is illustrated to be well over 1.05 times the ball head 76 diameter.

Claims 2, 3, 5, 7, 9, 10, 15, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over McLean, US 2002/0116068 A1. The further limitations of claims 2, 3, 7, and 10 would have been obvious for reasons similar to those given above. Regarding claim 5 and others, an offset of between 1.5 and 2.5 mm for the center of rotation 37 relative to the shell

center **39** (Figures 10 and 11) would have been obvious to the ordinary practitioner using routine experimentation in order to optimize range of motion (paragraph **0048**), particularly in the absence of any disclosed criticality for such a range.

The Applicant's remarks with respect to the Bouvet document have been considered. Because the spherical head **2** is represented by a major portion of a *circle* rather than by an elliptical or ovoid distortion, the drawing of Figure 1 is to scale relative to a Cartesian coordinate system. Depths of thin coatings or layers are sometimes exaggerated for illustrative purposes, but none of the features in question constitute thin coatings or layers. One of ordinary skill would have interpreted the arrows originating from points **40** and **41** as representing values for radii of curvature, particularly since Bouvet specifically identifies reference character **43** as being such a value or distance measurement (column 8, lines 35-40). Therefore, the ordinary practitioner would have concluded that the drawing of Figure 1 is to scale relative to a spherical coordinate system (involving a radial coordinate) for clearly and accurately conveying the dimensional comparisons (e.g., column 8, lines 22-26) of Bouvet's claimed invention.

The Applicant's comments on the McLean patent have also been reviewed. A comparison of Figures 1 and 12 reveals a consistency in the shapes and dimensions except that the space filled by structural member **14** in Figure 1 is occupied by shell **46** and liner **38** in Figure 12. One of ordinary skill would thus have concluded that the ratios of slide pairing diameters are fairly accurately portrayed in Figure 12 and others, particularly in view of the need to depict offsetting centers **37** and **39**. The ordinary practitioner would have been aware that slide pairing diameter ratios lying between 1.05 and 5 were known in the art for a long time (e.g.,

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US 4,678,472: Figure 2; column 9, lines 63-64) and would have had no reason for believing that the aforementioned drawings distort the corresponding ratios of the applied prior art.

Claims 4, 8, 12, 13, 17, and 20 are allowed.

Claims 14 and 18 would be allowable if rewritten or amended to overcome the rejection under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

All claims are drawn to the same invention claimed in the application prior to the entry of the submission under 37 CFR 1.114 and could have been finally rejected on the grounds and art of record in the next Office action if they had been entered in the application prior to entry under 37 CFR 1.114. Accordingly, **THIS ACTION IS MADE FINAL** even though it is a first action after the filing of a request for continued examination and the submission under 37 CFR 1.114 (MPEP § 706.07(b)). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dave Willse, whose telephone number is 571-272-4762 and who is generally available Monday, Tuesday, and Thursday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Corrine McDermott, can be reached on 571-272-4754. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.



Dave Willse  
Primary Examiner  
Art Unit 3738